

REMARKS

In response to the Office Action restricting the claims, mailed on February 4, 2002, applicants elect Group I (claims 1-22) and species as previously described. Applicants also assume that the restriction to Formula 2 is an error and that the restriction is to Formula 3.

However, applicants respectfully assert that such a restriction is improper. At the outset, applicants note that all the claims are directed to the structure designated as formula 3. More, specifically, claims 1-8 recite a composition, and claims 9-16 recite a method of performing a procedure by administering the composition of formula 3. Applicants now provide the following analysis in support of their assertion.

First, the Examiner's restriction forces applicants to fragment the invention they claimed within a single claim. Under *In re Weber, Soder, & Boksay*, 198 U.S.P.Q. 328, 331-32 (C.C.P.A. 1978) (copy attached) this is not permitted.

The invention in *Weber* related to cyclic diamine derivatives possessing a common psychotherapeutic property and was identified by a single generic formula expressed in Markush format. The instant invention relates to azo derivatives possessing a common physiological property and the derivatives are identified by a single generic formula (formula 3) expressed in Markush format.

In *Weber*, the court viewed the Examiner's restriction as tantamount to a refusal to examine. It held that the United States Patent and Trademark Office authority to restrict between claims of an application reciting one or more independent and distinct inventions, but does not have the authority to require an applicant to divide

up a single claim and present it in different applications; this would allow an Examiner, rather than an applicant, to define an invention in violation of 35 U.S.C. §121, ¶2 ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention", emphasis added). Weber at 332. While recognizing the need for efficiency in limiting each application to one invention, the court stated that

...in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights [of the applicant] are paramount.

Second, §803.02 of the MPEP states that if the claims have unity of invention, it is improper to refuse to examine "that which applicants regard as their invention". Unity of invention exists where compounds included within a Markush group share a common utility and share a substantial structural feature as being essential to that utility.

With regard to the instant application, all the claimed compounds share a single core azo structure as shown in formula 3, and have the same utility as receptor-targeted azo derivatives and their bioconjugates for phototherapy of tumors and other lesions.

For the reasons discussed, applicants respectfully request that the Examiner reconsider the restriction requirement.

The specification and claims 1 and 8 have been amended to correct typographical errors in the application and introduce no new matter.

All pending claims read on the elected species. Early and favorable examination on the merits is respectfully requested upon receipt and entry of the preliminary amendment.

CONCLUSION

For the foregoing reasons, applicants submit that the claims are patentable, and an early Notice of Allowance is respectfully requested. Applicants know of no fee due with this submission. However, if any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account 23-3000.

The Examiner is invited to contact applicants' undersigned representative with any questions.

Respectfully submitted,

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